It is believed no fee is due. If additional fees are required however, the Assistant Commissioner is authorized to deduct the necessary charges from Deposit Account 20-1504 (MICE-0083-US).

Specification

The specification was amended at pages 11 and 19 to correct typographical errors. The proposed amendments do not introduce new matter.

Figures

Substitute figure 1 with proposed amendments shown in red are attached to this Reply. The proposed amendment conforms the figure with the written specification at page 7, lines 8 through 10. The proposed amendment does not introduce new matter.

Section 103 Rejections

The Examiner has rejected claims 1 through 33 as allegedly being unpatentable under 35 U.S.C. 103(a) over U.S. Patent 5,794,032 to Leyda in view of U.S. Patent 5,794,052 to Harding, the combination of Leyda, Harding and U.S. Patent 5,748,980 to Lipe et al. (hereinafter Lipe), or the combination of Leyda, Harding and admitted prior art. Specifically, the Examiner asserts that:

> As to claim 1, Leyda (col 5 ln 36 to col 6 [sic] ln 16) teaches generating an external configuration file ... containing information about a plurality of devices ... identifying a particular device ... [and] installing a driver ... according to the information stored in the external configuration file and the particular device's identity ... Harding teaches installing the operating system according to information stored in a setup file. (Office Action at paragraph 2, page 2.)

With respect to Leyda, it is respectfully submitted the Examiner has ignored the explicit teaching of the specification which clearly distinguishes

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external configuration files in accordance with the invention from internal configuration files in accordance with Leyda. At page 10, lines 8 through 16, the specification distinguishes between internal and external configuration files in the following·manner:

> As mentioned above, the OS installation software also contains a configuration file, which shall be referred to as an "internal" configuration file [see page 4, lines 8-17 of the specification]. The term "external" is used here to distinguish the configuration file of the invention from the internal configuration file of the OS installation software ... the external configuration file is not part of the OS installation software. (Emphasis added.)

Thus, not only does Leyda not teach installing the operating system according to information stored in the external configuration file and the particular device's identity as acknowledged by the Examiner (Office Action at paragraph 2, page 2), Leyda totally fails to teach or suggest the use of an external configuration file as recited in independent claims 1, 10 and 19.

With respect to Harding and as pointed out in Assignee's prior Response (filed June 2, 1999 in response to the Office Action of March 3, 1999), a software setup program in accordance with Harding is an executable program (not a configuration file -- internal or external) that is designed to expand a pre-installed operating system so as to include user specified language aspects. Specifically, Harding states:

> [A] minimal disk operating system runs a software setup program which installs the end user selected language version of the disk operating system and merges certain factory loaded files into the user selected language operating system. A software installation program is then run which implements the changes necessitated by each of the modules for proper operation thereby resulting in a disk operating system that is properly configured for the operation of the combination of software programs. (Abstract; see also col. 12, lines 50-53; and

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col. 14, lines 11-16 which explicitly cites the need and benefit of using a pre-
installed operating system.)

The mere fact that a software setup program in accordance with Harding utilizes a setup file teaches absolutely nothing about loading an operating system using an external configuration file as recited in independent claims 1, 10 and 19.

For the reasons cited above and in the Assignee's prior Response, Leyda does not teach, describe or suggest the use of an external configuration file to install an operating system in accordance with the claimed invention. Similarly, Harding does not teach, describe or suggest the use of an external configuration file to install an operating system in accordance with the claimed invention.

With respect to the combination of Leyda and Harding, neither reference (explicitly or implicitly) suggests or motivates the Examiner's combination as required by section 103. Further, the Examiner's "statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." M.P.E.P. 2143.01 quoting *Ex parte Levengood*, 28 U.S.P.Q.2d (BNA) 1300 (Bd. Pat. App. & Inter. 1993). The Court of Appeals for the Federal Circuit has held time and again that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568, *quoting Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 U.S.P.Q. (BNA) 644, 647 (Fed. Cir. 1986); *see also, e.g., In re Roufett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (motivation to combine is required because without it, "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together

elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability.")

If the Examiner believes that such a motivation exists, the Examiner is requested to indicate specifically where in the cited references such a suggestion is found. If the Examiner is relying on personal knowledge that one of ordinary skill in the art would have combined the cited references as alleged, the Examiner is requested to provide an Affidavit so stating in accordance with 37 C.F.R. 1.104(d)(2) and M.P.E.P. 2144.03.

In light of these remarks, independent claims 1, 10 and 19 are patentable over the combination of Leyda and Harding. Dependent claims 2 through 9, 11 through 18 and 20 through 33 are patentable for at least the same reasons.

CONCLUSIONS

Reconsideration of pending claims 1 through 33, in light of the above remarks and amendments is respectfully requested. If, after considering this reply, the Examiner believes that a telephone conference would be beneficial towards advancing this case to allowance, the Examiner is strongly encouraged to contact the undersigned attorney at the number listed.

_10-18-1999_
Date

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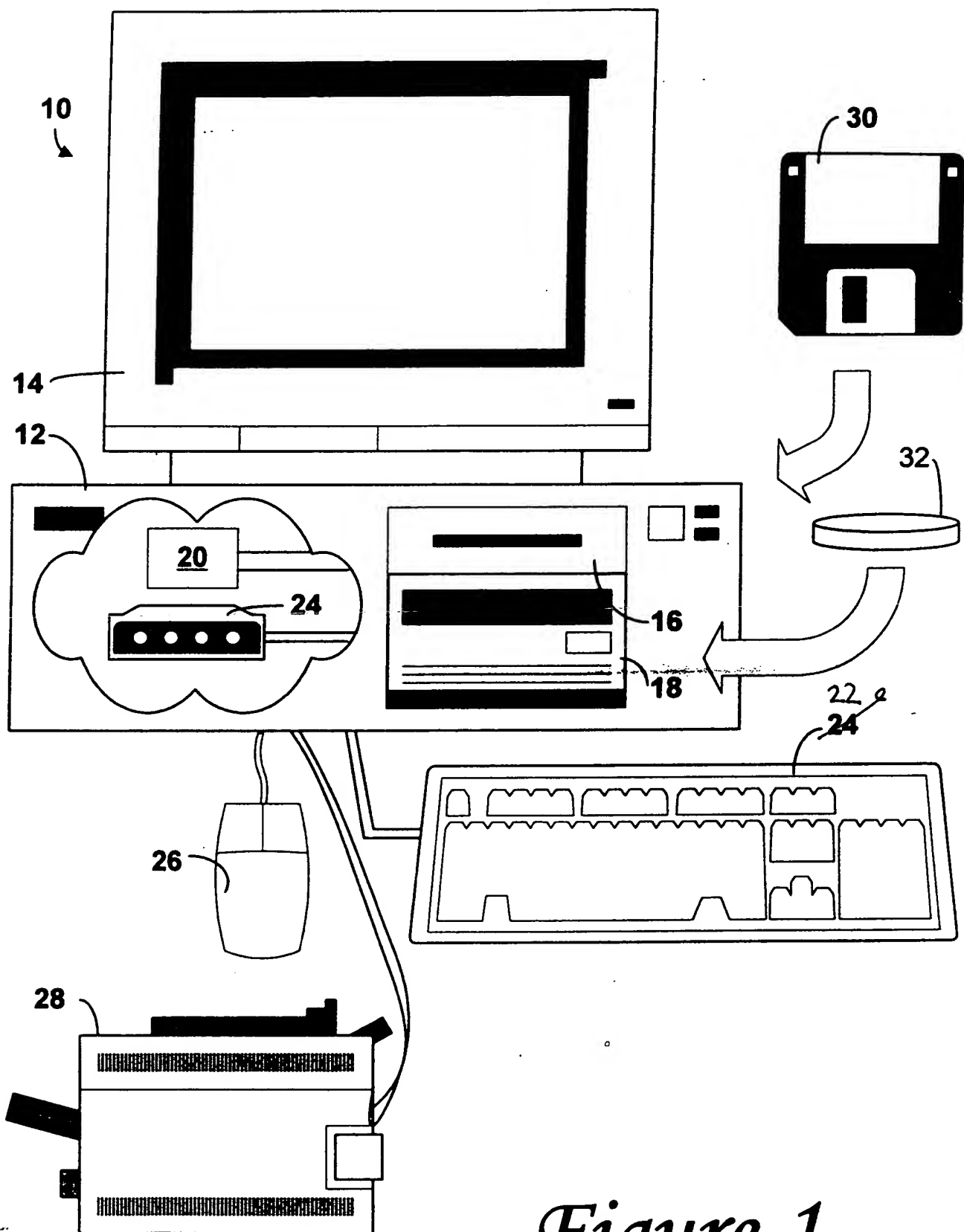Voice: 713-468-8880
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Figure 1